

REMARKS

Reconsideration of this application is requested.

A new abstract has been provided. It is believed that this abstract meets the Examiner's requirements.

The claims have been amended to obviate the Examiner's objections thereto and the Section 112, 2nd ¶ rejection of claim 4. Reconsideration of these aspects of the action is requested.

The Examiner is also requested to reconsider the Section 102(e) rejection of the applicants' claims based on Buckmann et al. (U.S. Publication No. 2004/0039089). For one thing, the Buckmann et al. publication is not citable as prior art against the present case. Buckmann et al. was not published until February 26, 2004. This is subsequent to the applicants' PCT and UK filing dates. While the Buckmann et al. PCT filing date (October 11, 2001) is prior to the applicants' UK filing date, it is noted that Buckmann et al. is only cited under Section 102(e) and cannot qualify as prior art because of the provisions of Section 103(c), it being noted that Buckmann et al. and the present case are commonly assigned and the inventors involved had an obligation to assign to said common assignee when the respective inventions were made.

Furthermore, while Buckmann et al. should not qualify as prior art under Section 102(e), it is noted that the respective inventions are patentably distinct, i.e. in Buckmann et al., the oligomer is crosslinkable while in the applicants' case, the oligomer is non-crosslinkable. This is a substantive difference so that Buckmann et al. and the present case are drawn to patentably distinct inventions.

In view of the foregoing, the Examiner is requested to reconsider and withdraw the Section 102(e) rejection of the claims herein based on the Buckmann et al. published application.


The Examiner's comments (Section 8 of the action) regarding U.S. Patent 6,303,189 (Gray) have been noted. There is no rejection of record based on Gray. However, it is noted that the reference does not disclose or suggest the applicants' invention. For one thing, Gray utilizes a crosslinkable polyurethane dispersion with a latex polymer while the applicants' claims call for a non-crosslinkable water-dispersible

oligomer with a dispersed polymer. This is a fundamental difference between the applicants' invention and Gray's disclosure.

Furthermore, as shown by the attached declaration of Jurgen Scheerder, Gray's compositions do not provide open times of the order called for by the applicants' claims. Admittedly, Gray is concerned with a method for extending the open time of an aqueous coating composition comprising a film-forming vinyl polymer by adding thereto an aqueous polyurethane dispersion which has a Tg below that of the vinyl polymer. Viscosities, open time and other drying properties are not intrinsically related to the molecular weight and, therefore, cannot be said to be inherently disclosed. However, Gray's Example 1, sample C, has been repeated as shown by the Scheerder declaration, the only difference being that instead of Sancure 1818 (Col. 4, line 11, Sancure 815 (Col. 3, line 39) was used as Sancure 1818 is no longer commercially available. The open time was tested according to the method given in the present application and was found to be 12 to 14 minutes, well outside the open time of at least 20 minutes required for the applicants' compositions. Clearly, therefore, the applicants' compositions differ fundamentally from Gray. Accordingly, it is submitted that the applicants' claims are patentable over Gray.

The application is thought to be in condition for allowance and such action is requested.

Respectfully submitted,
MORGAN LEWIS & BOCKIUS LLP

By 
Paul N. Kokulis
Reg. No. 16,773

Date: December 7, 2005

Customer No. 09629
1111 Pennsylvania Avenue, N.W.
Washington, D.C. 20004
Phone: (202) 739-3000
Facsimile: (202) 739-3001
Direct: (202) 739-5455